

REMARKS**1. The Amendments and the Support Therefor**

Claim 2 has been canceled, one new claim 22 has been added, and claims 3, 4, 13, and 15-19 have been amended to leave claims 1 and 3-22 in the application. Regarding the amendments:

- Claims 3 and 4 have been amended to incorporate canceled claim 2;
- Claims 13 and 15-19 are amended to address possible confusion regarding which "sidewall" is being referred to, i.e., these claims are amended to more specifically indicate whether the "shelf sidewalls" or "tire sidewalls" are being discussed (as in, for example, claim 12);
- New claim 22 is supported by (for example) the drawings.

2. Section 1 of the Office Action: Information Disclosure Statement

Regarding the allegedly missing reference – a website printout – this relates to a clock formed with a (fake) tire and fender about its rim. Since it is not believed to be any more relevant than other submitted references (e.g., D445,778 to *Eiler*, D394,517 to *Gebhard, Sr.*, etc.), i.e., it is a cumulative reference, the website printout is not being formally resubmitted as per 37 CFR §1.97(b). Nevertheless, a copy of the relevant portion of the printout is appended, and if the Examiner feels the reference is *not* cumulative, the undersigned attorney can be contacted regarding making a formal resubmission.

3. Section 2 of the Office Action: Specification

The objections to the specification are believed to be obviated by the specification amendments provided earlier.

4. Section 3 of the Office Action: 35 USC § 103 Rejections

Independent claims 1, 15, and 19 (as well as their dependent claims 2-4, 11, 12, 16, 18, and 20) have been rejected as obvious over D445,778 to *Eiler* in view of D376,286 to *Duarte*, with these rejections asserting that the *Eiler* tire provides “a distinct aesthetic property to the speaker cabinet of *Eiler* and therefore, would provide the same benefit to the cabinet of *Duarte*,” and with the Examiner providing a drawing of the allegedly obvious combination (which is appreciated, since this is of great assistance in clarifying the resulting combination).

Kindly reconsider the rejection; we submit that one of ordinary skill who had no knowledge of the claimed invention, and who knew of the *Eiler* reference and the *Duarte* reference, would not truly see any real and objectively ascertainable benefit (aesthetic or otherwise) to making the combination asserted by the rejection. As noted in MPEP 2143, for one or more references to render an invention obvious, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . The teaching or suggestion to make the claimed combination . . . must be found in the prior art, not in applicant's disclosure.” MPEP 2143.01 then provides greater detail:

- “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”
- Additionally, even if “the references relied upon teach that all aspects of the claimed invention were individually known in the art, [this] is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.”

The Court of Appeals for the Federal Circuit has emphasized that this need for an “objective reason” to combine or modify references is critical: the suggestion or motivation to combine or modify must be a *true and objectively ascertainable* one which would be noted and appreciated by an ordinary artisan, and it must be specifically pointed out and explained, in order to guard

against the use of hindsight.¹

Here, an ordinary artisan who sought to improve *Duarte*, whether aesthetically or for any other purpose, would not in fact see any real and objectively ascertainable benefit to incorporating the tire of *Eiler* in the manner asserted by the rejections. Consider:

- (1) From a utilitarian standpoint, the Applicant's invention usefully allows its shelving to be supported and strengthened by the tire, which provides an encircling band which is not parallel to the planes of the shelves (i.e., the tire serves as a sort of "truss" between the parallel shelves). *Duarte*, on the other hand, has a front "rim" – the bounding annular flange at the front of the *Duarte* cabinet – and thus no benefit is gained from addition of a tire: the encircling band provided by a tire's tread surface, and the front support provided by a tire's sidewall, is already provided by *Duarte*'s front "rim".
- (2) From an aesthetic standpoint, consider that *Duarte* shows a cabinet having a concave interior display area, where the display diameter gradually diminishes from front to back so that the shelves (and any items resting thereon) are essentially "thrust out" at the viewer. Note that the concave display area will help to focus attention on the interior of the display; further, the inwardly-receding shelf edges will help to make any items resting on the shelves appear larger (owing to the "false perspective" effect of the inwardly-receding shelf edges). However, if the *Duarte* cabinet were fit into the *Eiler* tire, these aesthetic benefits are destroyed: the sidewalls of the tire would obstruct the circumference of the *Duarte* display, and ends of the *Duarte* shelves would be obscured within the

¹ See, e.g., *In re Lee*, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002) ("The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [Citing cases.] The need for specificity pervades this authority."); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (obviousness requires "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."); *In re Rouffet*, 47 USPQ2d 1453, 1457-1459 (Fed. Cir. 1998) (emphasizing the need for the Examiner and/or the Board to specifically explain the location and content of the alleged suggestion/motivation in the prior art.) Also see, e.g., *Winner International Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000): "the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'"

cavernous interior of the *Eller* tire. This is contrary to *Duarte's* approach of fully displaying – and indeed emphasizing – the full width of each shelf.. See MPEP 2143.01 (subsection entitled “The Proposed Modification Cannot Render The Prior Art Unsatisfactory For Its Intended Purpose”).

- (3) Looking to *Eller*, this reference may place a speaker unit within the tire, but no problem is presented in doing so: the speaker cone is in no way obscured. Placing a shelving unit in a tire in the manner asserted by the rejections is a different matter (particularly where the shelving unit is intended to showcase the entire length of each shelf , as in *Duarte*): access to the shelves is restricted (and some shelf space may effectively be lost), as is the view of the shelves.

Thus, in summary, and keeping in mind that obviousness requires a real and evident suggestion to make the asserted combination/modification, please consider: would one who sought to improve *Duarte* – whether for aesthetic or utilitarian purposes – *truly* do so by enclosing *Duarte* in a tire, which would provide no utilitarian benefit, and which would obscure *both* access to *and* visibility of the ends of the shelves? In particular, would an ordinary artisan do so where *Duarte's* concave design is antithetical to this modification (since *Duarte* seeks to expose the shelf ends)? We submit that this is not the case, and no reasonable artisan would in fact see any real benefit to making the asserted modification. If the Examiner nevertheless believes that there is in fact some true suggestion of any real benefit to be attained by such a combination, kindly identify with particularity the location and content of the alleged suggestion so that the Applicant may better respond.²

The dependent claims are believed to be allowable for at least the same reasons as independent claims 1, 15, and 19. Also please note the following reasons why they are independently allowable. Regarding claim 3, if a back panel was spaced from the tire sidewall

² “When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference,” *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); “When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references or make the modification,” *In re Mayne*, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997); see also 37 CFR §§1.104(c)(2).

as recited, it would be partially obscured by the sidewall – and again, this is contrary to the teachings of *Duarte* and *Eiler*, and thus claim 3 should be regarded as unobvious even if claim 1 is still regarded to be obvious. The same is true of claim 12: it is contrary to the references to have obscured shelf sidewalls, particularly where *Duarte* seeks to emphasize their visibility. The same is true of claim 16: if the shelves are affixed between the opposing sidewalls of the tire, this too would obscure the shelf ends in a manner contrary to the references. As for claims 18 and 20, shelves affixed to the back panel as recited would also be at least partially obscured by the recited tire sidewalls, and thus these claims recite unobvious matter which is contrary to the purposes of the references.

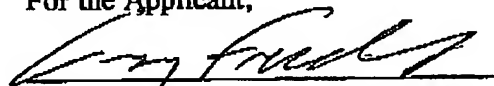
5. New Claim 22

New claim 22, which ultimately depends from claim 19, is submitted to be allowable for at least the same reasons as claim 19. Additionally, new claim 22 is submitted to be independently allowable because it is contrary to the purposes of the references to obscure the ends of the shelves behind the tire sidewall.

In Closing

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

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ATTACHMENTS:

- Weiner Distributing website